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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,014	07/24/2003	Robert J. Flathau	SSP-30492-C	9949
22202	7590	05/12/2005	EXAMINER	
WHYTE HIRSCHBOECK DUDEK S C			SAFAVI, MICHAEL	
555 EAST WELLS STREET			ART UNIT	
SUITE 1900			PAPER NUMBER	
MILWAUKEE, WI 53202			3673	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p align="center">10/626,014</p>	<p>Applicant(s)</p> <p align="center">FLATHAU, ROBERT J.</p>	
	<p>Examiner</p> <p align="center">M. Safavi</p>	<p>Art Unit</p> <p align="center">3673</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/23/05</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3673

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 38-51 have been renumbered 26-39, respectively.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Foy.

Foy discloses, Figs. 1-8, using dimensioned form-work panels 7 with a corner bracket 1 in making a dimensioned building member. An outer surface of the bracket body, as along 3 or 4 or 5, contacts the form-work panels and is connected thereto. The outer surface of the bracket is configured to impart a shape to the building member as along 2. The recitation of "U.S.-dimensioned" or "metric-dimensioned" does not define any structure or feature differing from what is disclosed within Foy. The terms "U.S.-dimensioned" and "metric-dimensioned" only serve to define any given dimension. The

Art Unit: 3673

corner bracket of Foy can be utilized with any given dimension of panel, (i.e., any given dimension of length, width, and thickness). Therefore, no differentiation is made between the language of the instantly rejected claims and Foy. The rejected method claims merely define a corner bracket assembled to a panel or panels. Indeed, Foy discloses a plurality of dimensions of building member as, for example, in Figs. 5, 6, and 7.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 26-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,865,859 in view of either of Riehl or Podgurski. Claims 1-11 of U.S. Patent No. 6,865,859 define the invention presented in claims 26-39 of the instant application *minus* the specific reference to "contacting the outer surface of the bracket body with the plurality of U.S.-dimensioned form-work panels." However, each of Riehl and Podgurski disclose

Art Unit: 3673

contacting the outer surface of the bracket body with the plurality of form-work panels. Therefore, it would have been obvious to one having ordinary skill in the art to add to the invention defined by claims 1-11 of U.S. Patent No. 6,865,859 a bracket surface which contacts the form-work panels of the instant claims, to thus provide a sealed form within which to accept concrete. As well, claims 1-11 of U.S. Patent No. 6,865,859 define the invention presented in claims 26-39 of the instant application *plus* a specific reference to "standard U.S. customary unit dimension" or "standard metric unit dimension." However, to have utilized the corner bracket recited in claims 1-11 of U.S. Patent No. 6,865,859 with any panel having any specific U.S. or metric dimension, standard or otherwise, as well as form a building member having any specific U.S. or metric dimension, standard or otherwise, would have constituted an obvious expedient to one having ordinary skill in the art.

### ***Response to Arguments***

Applicant's arguments filed February 09, 2005 have been fully considered but they are not persuasive. Claim 26 recites "selecting a conversion corner bracket, the bracket selected for use with a plurality of U.S.-dimensioned form-work panels" and "using the plurality of U.S.-dimensioned formwork panels in making a metric-dimensioned building member by using the conversion corner bracket selected for use with the plurality of U.S.-dimensioned form-work panels." Claim 31 recites "selecting a conversion corner bracket, the bracket selected for use with a plurality of metric-dimensioned form-work panels" and "using the plurality of metric-dimensioned form-

Art Unit: 3673

work panels in making a U.S.-dimensioned building member by using the conversion corner bracket selected for use with the plurality of metric-dimensioned form-work panels.” Claim 26 is presented as a Markush or either/or recitation.

First of all the language to “selecting a conversion corner bracket, the bracket selected for use with a plurality of U.S.-dimensioned form-work panels” or “selecting a conversion corner bracket, the bracket selected for use with a plurality of metric-dimensioned form-work panels” defines nothing more than selecting a bracket which bracket can and may be used with a plurality of U.S.-dimensioned form-work panels or a plurality of metric-dimensioned form-work panels. Foy, indeed, shows such a bracket. The fact that Foy may not expressly state that the corner bracket 1 is used with either of U.S.-dimensioned or metric-dimensioned form-work panels or is used to make either of a U.S.-dimensioned building member or a metric-dimensioned building member does not preclude the application of Foy against the instant claims. The corner bracket 1 of Foy is shown as used with panels 7. Panels 7 have a dimension. The dimension of panels 7 can be expressed in U.S. dimensional units as well as metric dimensional units. As such, the panels 7 of Foy serve to read upon the recitation of a plurality of “U.S.-dimensioned form-work panels” as well as “metric-dimensioned form-work panels.”

And, The corner bracket 1 of Foy is shown as used with panels 7 to make a “building member”. The resulting “building member” has a dimension. The dimension of the resulting “building member” can be expressed in U.S. dimensional units as well as metric dimensional units. As such, the resulting “building member” of Foy serves to read

Art Unit: 3673

upon the recitation of a "metric-dimensioned building member" as well as a "U.S.-dimensioned building member."

Therefore, Foy serves to read upon the language recited within each of claims 26, 31, and 36. Applicant argues that Foy "does not teach using a conversion corner bracket." The Foy brackets 1 read upon "conversion corner bracket." Thus, Foy teaches, "using a conversion corner bracket." The term to "conversion corner bracket" appears as mere nomenclature and does not serve to define over the corner bracket of Foy. Otherwise, what does applicant intend to define by "conversion corner bracket"? The claims offer nothing more than what is shown by Foy, namely a corner bracket used with form panels to make a building unit. The instant claims do not present any limitations such as specific dimensions or sizes, which Foy may not specifically show. The instant claims merely present a corner bracket used with form panels to make a building unit.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3673

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



M. Safavi  
May 10, 2005

**MICHAEL SAFAVI  
PRIMARY EXAMINER  
ART UNIT 354**